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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,347	05/09/2005	Hansjorg Ander	RO4016US (#90568)	4202

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EXAMINER

BERNSHTEYN, MICHAEL

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/534,347

Applicant(s)

ANDER ET AL.

Examiner

Michael Bernshteyn

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action follows a response filed on July 27, 2006. Claims 1, 12 and 15 have been amended, claim 14 has been cancelled, and no new claims were added.
2. In view of amendment, the objection of claim 1 and the rejection of claim 15 under 35 U.S.C. 112, 2nd paragraph and 101 have been withdrawn.
3. Claims 1-13, 15 and 16 are pending.

Claim Rejections - 35 USC § 102

4. The test of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

5. The test of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
6. Claims 1-9, 12, 13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Inagi et al. (EP 0 735 122 A2), for the rationale recited in paragraph 4 of Office Action dated on April 25, 2006.
7. Claims 10-11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable as obvious over Inagi et al. in view of Weaver et al. (U. S. patent 6,713,641), for the rationale recited in paragraph 5 of Office Action dated on April 25, 2006.

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8. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Inagi et al. (EP 0 735 122 A2).

The disclosure of Inagi's reference resided in § 6 is incorporated herein by reference.

Inagi discloses that the adhesive base material can also be used in a form deposited on a commercially available support. Illustrative usable examples include plastic sheets made of polyethylene, polypropylene, an ethylene-vinyl acetate copolymer, vinylon, a polyester, polyurethane, nylon or the like; non-woven fabrics made of rayon, a polyester or the like; and woven fabrics made a polyester, an acrylic resin, silk, cotton or the like (page 5, lines 39-42).

Response to Arguments

9. Applicants traverse the rejection of claims 1-9, 12, 13 and 16 under 35 U.S.C. 102(b) as being anticipated by Inagi et al. (EP 0 735 122 A2). Applicant's arguments have been fully considered but they are not persuasive.

10. Applicants contend that Inagi et al. teach an adhesive base material comprising a polymer obtained by polymerization of (1) a glucosyloxyalkyl (meth) acrylate, (2) a hydroxyalkyl (meth)acrylate, (3) an alkyl(meth) acrylate and (4) a polyfunctional monomer. At age 2, line 54, Inagi et al. states that the polymer with the desired properties of the invention thereof is obtained by polymerization of the aforementioned "specific four monomers". To the contrary of Inagi, the polymer of the present invention is obtained by polymerizing (1) a polar (meth)acrylate with a Zerewitinoff hydrogen, (2)

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an apolar (meth)acrylate, and (3) a bi-, tri- or higher functional (meth)acrylate, or of a (poly)functional compound.

Hence, the polymer of the present invention is derived only from three different monomers set forth above and in claim 1, none of which is a glucosylox (meth)acrylate (page 7).

11. It is noted that claim 1 contains the following "A polymer composition which **can be** produced by polymerization of ..." The recitation of claim 1 "**can be**" does not exclude the usage of another components in the polymer composition.

Inagi's composition contains exactly the same three different monomers like the claimed composition with addition exactly the same amount of the same initiator and exactly the same amount of the same chemically inert medium (see the previous Office Action).

Therefore, all the limitations of instant claim 1 are expressly met by Inagi.

12. Applicants traverse the rejection of claims 10-11 and 15 under 35 U.S.C. 103(a) as being unpatentable as obvious over Inagi et al. in view of Weaver et al. (U. S. patent 6,713,641). Applicant's arguments have been fully considered but they are not persuasive.

13. Applicants contend that regarding the use of (meth) acrylated polyesters and (meth) acrylated polyurethanes in claims 10 and 11, the Examiner cites Weaver et al. as analogous art in which the features missing in Inagi are taught and disclosed. The Applicants respectfully disagree that the latter reference is analogous art and therefore applicable to the present situation (pages 11-12, the bridging paragraph). In the present

matter, the polymers according to Weaver et al. are used to produce colored X-ray films, which have no adhesive properties at all. Since the reference fails to discuss otherwise, it is presumed that this is also the case for the disclosed coating compositions (page 12, the last paragraph).

14. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

16. In response to applicant's argument that Weaver's references is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

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In this case, Weaver's reference discloses a **coating composition** wherein the polymerizable vinyl compounds comprise a solution of a polymeric, polymerizable vinyl compound selected from **acrylated** and **methacrylated polyesters**, acrylated and methacrylated polyethers, acrylated and methacrylated epoxy polymers, **acrylated** or **methacrylated urethanes**, and mixtures thereof, in a diluent selected from **monomeric acrylate** and **methacrylate esters** (claim 17, col. 25, lines 24-31). The acrylated or methacrylated polymers and oligomers typically are combined with monomers, which contain one or more acrylate or methacrylate groups, e.g., monomeric acrylate and methacrylate esters, and serve as reactive diluents. The unsaturated polyesters, which are prepared by standard polycondensation techniques known in the art, are most often combined with either styrene or other monomers, which contain one or more acrylate or methacrylate groups and serve as reactive diluents (col. 13, lines 9-17).

The coating compositions are suitable as adhesives and coatings for such substrates as metals such as aluminum and steel, plastics, glass, wood, paper, and leather (US'641, col. 15, lines 62-65).

Therefore both references are analogous art because they are from the same field of endeavor concerning coating and pressure sensitive adhesive polymer compositions.

17. It is worth to mention that Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teaching in the art and are applied to the specific limitations within the individual claim, other passages and

figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, **to fully consider the references in entirety as potentially teaching all or part of the claimed invention**, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

18. In the light of the discussion above, the rejection of record has not been withdrawn. The rejection remains in force.

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Bernshteyn
Examiner
Art Unit 1713

MB
10/13/2006


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